

**2. REMARKS/RESPONSE**

**2.1 STATUS OF THE CLAIMS**

*Claims 1 and 4-25 were pending at the time of the Action.*

*Claims 4 and 25 have been amended herein.*

*Claims 26-34 have been added herein.*

*Claims 1 and 4-34 are now pending in the application.* In accordance with 37 C. F. R. § 1.121, the pending claims are listed in **Section 1.2** hereinabove.

Applicant notes for the record that no rejections have been made against the pending claims under either 35 U. S. C. § 112, 1<sup>st</sup> paragraph, or 35 U. S. C. § 101.

**2.2 THE ATTORNEY DOCKET NUMBER HAS BEEN MODIFIED**

The attorney docket number for the present case has been modified. The new docket number is TS6737 (29402.26). Applicant appreciates the Examiner's so noting of this in all subsequent communication with the undersigned representative, and that the attorney docket number for this file be corrected to reflect this change.

**2.3 REQUEST FOR CONTINUED EXAMINATION (RCE)**

The present RCE is filed within the statutory six month period after the Final Action and is timely in light of the enclosed request for extension of time and fees.

**2.4 THE TYPOGRAPHICAL ERROR IN THE TITLE IS CORRECTED**

Applicant appreciates the Examiner's noting of the inadvertent misspelling of "methods" in the title submitted in the previous amendment. Applicant has provided the correct title in **Section 1.1** hereinabove.

## **2.5 SUPPORT FOR THE CLAIMS**

Support for the pending claims can be found throughout the specification and claims of the original as filed. Applicant certifies that no new matter was added as a result of the present amendment. New claims 26-34 read on the previously-elected species.

Support for new claims 26-34 can be found throughout the specification and original claims, including for example, in the teachings found in the Examples enumerated in the Specification (*e.g.*, those particularly described on pages 6-8).

Should any fees be deemed necessary in connection with entry of the amendment, and the addition of new claims, the Commissioner is hereby authorized to deduct any necessary amounts from Deposit Account. 08-1934, Order No. 29402.26.

## **2.6 THE REJECTION OF CLAIMS UNDER 35 U. S. C. § 112, 2<sup>ND</sup> PARAGRAPH, IS OVERCOME.**

*The Action at page 6 objected to claims 1, 4 and 25 under 35 U. S. C. § 112, 2<sup>nd</sup> paragraph, allegedly as being indefinite.*

Applicant respectfully traverse; however, in the interest of facilitating completion of the examination of the present case on the merits and procession to allowance and issuance, claim 25 has been amended to further clarify the “antecedent basis” issue raised by the Examiner.

With respect to Claim 1, Applicant again respectfully traverses and notes that “glossy” is not a term that is indefinite, as the definition is generally known, and particularly understandable to one of skill in the art of tire dressing formulations. Further to Applicant’s remarks in the paper filed with the Office on 2 December 2005, the term “glossy” has not been given a special or unique meaning in the Application that contradicts a standard dictionary definition, and as

such Applicant believes that the rejection is without foundation; he respectfully requests that the rejection be withdrawn.

**2.7 THE REJECTION OF CLAIMS UNDER 35 U. S. C. 103(A) IS OVERCOME.**

*Claims 1, 4, and 25 were rejected under 35 U. S. C. § 103(a) as obvious in view of Patitsas et al. (U.S. Patent No.5,149,591).*

*Claims 1, 4, and 25 were rejected under 35 U. S. C. § 103(a) as obvious in view of JP 64-000171.*

*Claims 1 and 4 were rejected under 35 U. S. C. § 103(a) as obvious in view of WO01/94453 in view of Patitsas et al. (U.S. Patent No.5,149,59).*

As to each rejection, Applicant respectfully traverses.

A finding of obviousness under 35 U. S. C. § 103 requires a determination of the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed subject matter and the prior art, and whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. John Deere Co.*, 148 USPQ 459 (U.S. S.Ct. 1966).

The relevant inquiry is whether the prior art suggests the invention and whether the prior art would have provided one of ordinary skill in the art with a reasonable expectation of success. *In re O'Farrell*, 7 USPQ 2d 1673 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success *must be founded in the prior art* and not in the Applicant's disclosure (emphasis added) *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, in the case of *In re Dow Chemical Co.* (837 F. 2d 469, 5, U.S.P.Q.2d 1529, Fed. Cir. 1988) the court held that an “obvious-to-experiment” standard is not an acceptable

alternative for obviousness, and that there must be a reason or suggestion in the art, *other than* the knowledge learned from the Applicant's disclosure.

Applicant also submits that the combination of references relied upon by the Examiner also clearly fails to satisfy the tripartite test of *In re O'Farrell* (7 U.S.P.Q.2d 1673, 1680, Fed. Cir. 1988). In *O'Farrell*, the Court held that in order for a single reference or a collection of references to obviate an invention, it must be shown that the reference(s) contain(s):

- (1) Detailed enabling methodology for practicing the claimed invention;
- (2) A suggestion for modifying the prior art to practice the claimed invention; and
- (3) Evidence suggesting that the invention would be successful.

In the present case (1) none of these references provides any specific teaching relevant to the question of how one of skill would proceed to prepare particular aqueous-based tire dressing compositions that comprise a film-forming polyurethane or one or more urethane acrylic copolymers in a liquid dispersion that further comprises an antifoaming agent, and most certainly does not provide any "detailed enabling methodology" for practicing the claimed invention; (2) none of the cited references in the present case provides any suggestion for combining the teachings of the cited art (*e.g.*, Patitsas *et al.*, JP 64-000171, and/or WO/01/94453 in any combination), or for modifying any of these prior disclosures in a manner that would allow one to arrive at the present invention; and (3) particularly none of the references provides evidence that the present methods would be useful in forming a dried glossy coating on a tire surface that would have a tensile strength of greater than or equal to 500 psi on a tire. The combination of these references also does not fairly teach or suggest that the present methods would be useful in forming a dried glossy coating on a tire surface that would have a tensile strength of greater than or equal to four *thousand* psi on a tire surface as exemplified in new claim 26. Furthermore, the

combination of Patitsas *et al.*, JP 64-000171, and/or WO/01/94453 in any combination also does not provide the expectation of success that the tire dressing compositions of the present application having a viscosity of 600 to 900 cps would be particularly desirable in methods of forming a dried glossy coating on a tire surface that would have improved performance properties such as maintaining resiliency and flexibility at ambient temperatures as low as -40°C. Clearly the rejection is improper as it fails the tripartite test of *In re O'Farrell*.

Applicant asserts that any combination of the cited references is, at best, merely an invitation for further experimentation in the field, and at most, an “obvious-to-try” situation. However, there is *no* reasonable expectation of success, *nor* is there the motivation or teaching to guide a skilled artisan how to achieve such success. The Federal Circuit, in the case of *In re Geiger* (815 F.2d. 686, 2 U.S.P.Q.2d 1276, Fed. Cir. 1987), held that obviousness cannot be established by combining the teachings of the prior art to produce a claimed invention, absent some teaching, suggestion or incentive supporting the combination. Again, Applicant believes that the rejection over Patitsas *et al.*, JP 64-000171, and/or WO/01/94453 in any combination fails the test established by *In re Geiger*.

For the cited combination of references to render the rejected and newly-presented claims legally obvious under 35 U. S. C. § 103, the references must provide one of ordinary skill in the art with a reasonable expectation of obtaining the results embodied by the pending claims.

The disclosures of Patitsas *et al.*, JP 64-000171, and/or WO/01/94453 (either alone, or in any combination) *cannot* obviate the claimed invention when the combination of references fails to provide both the required suggestion and the required reasonable expectation of success of generating tire dressing compositions that permit the formation of a dried glossy coating on a tire surface that would have a tensile strength of greater than or equal to 4000 psi on a tire, and the

such dried films would impart a resilient coating that would permit the tire to retain its glossy shine for periods of time as long as at least two months, even under extreme environmental conditions of very low ambient temperatures (*e.g.*,  $\leq -30^{\circ}\text{C}$ ). *None* of these references provide *any* teaching or suggestion for preparing such aqueous, polyurethane or urethane acrylic copolymers or for formulating such compositions with an antifoaming agent to impart the surprising and unexpected properties of enhanced shine duration of two or more *months*, even under extreme conditions of very low ambient environmental temperatures such as those down to and including  $\leq -30^{\circ}\text{C}$ .

Because the claims in the case particularly point out the distinct features of the inventive methods disclosed in the Specification, and because each of such claims is clearly distinguished over the previously cited art (either alone or in combination) Applicant believes that, as a matter of fact, the rejection advanced under 35 U. S. C. § 103 cannot stand. Applicant respectfully submits that all aspects of the instant 35 U. S. C. § 103 rejections have been overcome, and withdrawal of the rejections is now earnestly solicited.

Both as a matter of fact and of law, the Applicant believes that the obviousness rejection over Patitsas *et al.*, JP 64-000171, and/or WO/01/94453 (taken alone, or in any combination) is improper and must be withdrawn, particularly in view of the surprising and unexpected results obtained by the particular tire-dressing formulations used in the practice of the presently-claimed methods.

As such, Applicant believes that the obviousness rejection is overcome, and respectfully requests that the rejection be withdrawn. Applicant furthermore believes that all of the newly-added claims are fully patentable over the art of record, and respectfully request that no similar obviousness rejections be advanced against them in the following Action, and that a Notice of

Allowance be granted such that rejoinder of the non-elected species may occur, and the full scope of the claimed invention be issued to patent. Applicant respectfully requests that in view of the amendment, the remaining non-elected species be rejoined and examined on the merits in the next non-final Office Action issued by the Office.

## **2.8 REQUEST FOR EXAMINER INTERVIEW**

Pursuant to M. P. E. P. § 713.01 and 37 C. F. R. § 1.133, owing to a change in primary counsel for the continued prosecution of the present application, Applicant hereby requests an interview with Applicant's new representative in order to facilitate an expeditious conclusion of prosecution on the merits in the present application, and to permit expedited allowance and issuance of the pending claims prior to the issuance of a first action on the merits in the Request for Continued Examination filed herewith.

Consistent with M. P. E. P. §§ 408 and 713.09, Applicant requests that Examiner Cameron contact the undersigned representative within the next 30 days to arrange a telephonic Examiner Interview at a mutually convenient time to discuss favorable disposition of the case and the resolution of the issues of record as soon as she has had the opportunity to review and consider the present paper, and before issuance of a first action on the merits in the RCE.

Mindful of the Examiner's extensive docket, appreciative of her diligence in the Examination of this case, and in an effort to secure a speedy allowance of the application, Applicant has elected to file the present papers electronically using the Office's Electronic Filing System (EFS) to permit the Examiner's ready access to electronic versions of these documents immediately upon filing. Applicant appreciates the Examiner's attention to the remarks herein in advance of an Examiner Interview.

## 2.9 CONCLUSION

It is respectfully submitted that all claims are fully enabled by the Specification, and that all claims are definite, and free of any concerns of prior art. Applicant believes that the claims are acceptable under all sections of the Statutes and are now in conditions for ready allowance, and that all of the concerns of the Examiner set forth in the Final Action have now been resolved and that the pending claims are in condition for immediate allowance.

Applicant has responded fully to the Notice of Non-Compliant Amendment issued by the Office on November 30, 2006, and earnestly solicits entry and consideration of the present amendment and remarks, and that a Notice of Allowance be issued in this case with all due speed.

Should Examiner Cameron have any questions or require any additional information, a telephone call to the undersigned Applicant's new representative is respectfully solicited.

Respectfully submitted,

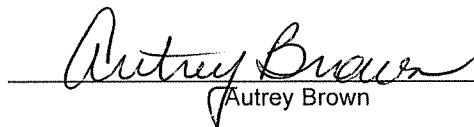


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### Certificate of Service

I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on December 13, 2006.

  
Autrey Brown